

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 09/925,738
ATTORNEY DOCKET NO. Q65271

AMENDMENTS TO THE DRAWINGS

The Patent Office objects to the Drawing under 37 C.F.R. § 1.83(a) as lacking all the elements recited in the claims. Applicants have attached a Replacement Drawing Sheet and a New Drawing Sheet, and submit that that § 1.83(a) objection has been overcome. No new matter was added.

Attachment: One (1) Replacement Sheet

One (1) New Drawing Sheet

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REMARKS

Applicants thank the Patent Office for acknowledging Applicants' claim to foreign priority, and for indicating that the certified copy of the priority document, European Patent Application No. 00402306.5 dated August 18, 2000, has been made of record in the file.

Applicants thank the Patent Office for initialing the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on August 10, 2001, thereby confirming that the listed references have been considered.

Applicants herein cancel the Abstract of the Disclosure, and substitute therefor a new Abstract of the Disclosure. Entry of the new Abstract is respectfully requested.

Claims 1-18 have been examined on their merits.

Applicants herein cancel claim 10 without prejudice and/or disclaimer.

Applicants herein add new claims 19-21. The new claims 19-21 are fully supported by the specification as filed, and do not add any new matter. Entry and consideration of the new claims 19-21 is respectfully requested.

Claims 1-9 and 11-21 are all the claims presently pending in the application.

1. The Patent Office objects to the written disclosure as containing informalities, *i.e.*, claim numbers incorporated into the specification. Applicants herein amend the written disclosure, and submit that the objection to the written disclosure has been overcome. Applicants request withdrawal of the objection to the written disclosure.

2. Claims 1-18 stand rejected under 35 U.S.C. § 112 (1st para.) as allegedly being based on a disclosure that is not enabling. The rejection of claim 10 is now moot due to its cancellation. Applicants traverse the § 112 (1st para.) rejection of claims 1-9 and 11-18 for at least the reasons discussed below.

The Patent Office states that, since the claims recite a marker device or functions performed by the marker device, the claims are not enabled by the disclosure. Applicants remind the Patent Office that “a patent applicant is free to recite features of an apparatus either structurally or functionally.” *In re Schreiber*, 128 F.3d 1473, 1478, 44 U.S.P.Q.2d 1429 (Fed. Cir. 1997); citing *In re Swinehart*, 439 F.2d 210, 212, 169 U.S.P.Q. 226, 228 (C.C.P.A. 1971). “A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.” *In re Swinehart*, 439 F.2d 210, 169 U.S.P.Q. 226 (C.C.P.A. 1971).

With respect to claims 1-8, these claims are method claims that are directed to a method of marking data packets. It is not necessary to recite specific structure as indicated by the Patent Office for these claims.

Applicants herein amend claims 9 and 11-18 to recite specific structure directed to an apparatus for marking data packets.

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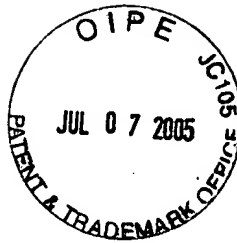
Applicants submit that the § 112 (1st para.) rejection of claims 1-9 and 11-18 has been overcome, and request that the Patent Office reconsider and withdraw the § 112 (1st para.) rejection of claims 1-9 and 11-18.

3. Claims 9-18 stand rejected under 35 U.S.C. § 112 (2nd para.) as allegedly being indefinite. The rejection of claim 10 is now moot due to its cancellation. Applicants traverse the § 112 (2nd para.) rejection for at least the reasons discussed below.

Applicants herein amend claims 9 and 11-18 to recite specific structure directed to an apparatus for marking data packets.

Applicants submit that the § 112 (2nd para.) rejection of claims 9 and 11-18 has been overcome, and request that the Patent Office reconsider and withdraw the § 112 (2nd para.) rejection of claims 9 and 11-18.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Paul J. Wilson
Registration No. 45,879

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

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